

1 Remarks

2 Status of the Claims

3 No claims have been added, amended, cancelled or withdrawn as of this
4 Response. Therefore, the status of the pending claims 1-36 is as provided above.
5

6 Acknowledgment of Declaration under 37 C.F.R. § 1.131

7 The Examiner has stated that the Declaration as filed on December 9, 2005 is
8 sufficient to overcome U.S. Patent Application Publication No. 2001/0037267 A1
9 ("Sato et al.") (page 2 of Office action). The Applicants acknowledge, with thanks,
10 the Examiner's statement as just described.
11

12 Preliminary Remarks regarding Claim Terminology and Context

13 The Examiner has stated that the term "imaging device" is supported within
14 the text of the Specification, but such does not meet the requirements for a "clear
15 definition" (page 3 of Office action). Respectfully, the Applicants assert that the term
16 "imaging device", in the context of the pending application, is well known to one of
17 ordinary skill in the relevant art(s), as well as being adequately supported by
18 example at page 1, lines 5-12, of the pending Application as originally filed, as well
19 as throughout the balance of the text thereof. Thus, the Applicants contend that the
20 term "imaging device", as used in the pending Application and Claims, is clearly
21 defined with respect to the area(s) of art to which it pertains, without ambiguity or
22 over-breadth.

23 The Examiner has also stated that "a conventional coupon 36", as recited in
24 U.S. Patent No. 5,483,049 ("Schulze"), is a "consumable" under the same definition
25 as that term is used in the pending Application and Claims (page 3 of Office action).
With respect, the Examiner is mistaken, for at least the following reasons:

1 1) In the context of the pending Claims and Application, the term
2 “consumables” plainly and without exception refers to those things which serve as
3 raw materials for the production of another entity. Non-limiting examples of such
4 consumables include paper media, transparency media, laser-imaging toner, and ink
5 (page 1, et seq. of Application as originally filed). In turn, such consumables are
6 used in (essential to) the production of, for example, a printer document, a hardcopy
7 image of a photograph, etc. Thus, in the context of the pending Application,
8 consumables are processed so as to derive – and are made integral with - a finished
9 product or deliverable for a user of an imaging device; and

10 2) In contrast to (1) above, a conventional coupon (36) under Schulze is
11 accepted by a coupon exchanger (32) for purposes of being shredded and discarded
12 as waste (Col 7, line 65 to Col. 8, line 1 of Schulze). Thus, such a conventional
13 coupon (36) cannot be reasonably construed as a raw material used in (i.e.,
14 necessary to) the production of any other entity, as the only fate of such a
15 conventional coupon under Schulze is to be destroyed so as to prevent any future
16 use thereof (Col. 8, lines 1-4 of Schulze). In any case, a conventional coupon (36)
17 as recited by Schulze is not a “consumable” in the same context as used in the
18 pending Claims and Application.

19 In summary of the foregoing, a “consumable”, as that term is used in the
20 pending Claims and Application, is an entity or raw material essential to the
21 production of another entity. In turn, the term “consumption” refers to the use and/or
22 exhaustion of such a consumable (or consumables) during the production of another
23 entity (e.g., printing a document, imaging a photograph, etc.). Put another way,
24 there is no “consumption” of any material (e.g., paper, toner, etc.) that is not directly
25 essential to the production of another entity within the context of the pending
Application and Claims. In any case, the term “consumption” under the pending

1 Application is not synonymous with the surrender and destruction of conventional
2 coupons under Schulze.

3
4 Rejection of Claims under 35 U.S.C. § 102

5 Claims 1-8, 10-19, 21, 23-31 and 33-36 have been rejected under 35 U.S.C. §
6 102(b) as being anticipated by U.S. Patent No. 5,483,049 ("Schulze").

7 The Applicants respectfully disagree that claims 1-8, 10-19, 21, 23-31 and
8 33-36 are anticipated by Schulze.

9 As a starting point, the PTO and the Federal Circuit provide that §102
10 anticipation requires each and every element of the claimed invention to be
11 disclosed in a single prior art reference. (In re Spada, 911 F.2d 705, 15 USPQ2d
12 1655 (Fed. Cir. 1990).) The corollary of this rule is that the absence from a cited
13 §102 reference of any claimed element negates the anticipation. (Kloster
14 Speedsteel AB, et al v. Crucible, Inc., et al, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir.
15 1986).) Furthermore, **"[a]nticipation requires that all of the elements and**
16 **limitations of the claims are found within a single prior art reference."** (Scripps
17 Clinic and Research Found. v Genetech. Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d
18 1001, 1010 (Fed. Cir. 1991 (emphasis added).) Moreover, the PTO and the Federal
19 Circuit provide that §102 anticipation requires that there must be no difference
20 between the claimed invention and the reference disclosure. (Scripps Clinic and
21 Research Found. v. Genetech, Inc., id. (emphasis added).)

22 Accordingly, if the Applicants can demonstrate that any one element or
23 limitation in claims 1-8, 10-19, 21, 23-31 and 33-36 is not disclosed by Schulze, then
24 the respective claim(s) must be allowed.

25 In the following arguments, the Applicants will focus in particular on
independent claims 1, 10, 12, 17, 25 and 33, as the Applicants believe those claims
to be allowable over Schulze. It is axiomatic that any dependent claim which

1 depends from an allowable base claim is also allowable, and therefore the
2 Applicants do not believe it is necessary to present arguments in favor of each and
3 every dependent claim.

4
5 Claim 1

6 The Applicants contend that claim 1 (and rejected claims 2-8, which depend
7 therefrom), are not anticipated by Schulze. With respect to claim 1, that claim
8 includes the following recitations:

9
10 A method to promote the use of consumables in an imaging
11 device including a consumption detecting device, comprising:

12 detecting consumption of a consumable using the consumption
13 detecting device; and

14 when the consumption of a predefined quantity of the
15 consumable has been detected, rewarding a user of the imaging
16 device.

17 (Emphasis added.)
18

19 Schulze fails to provide a consumption detecting device, as recited in
20 combination with the other features and limitations of claim 1. Also, Schulze fails to
21 provide detecting consumption of a consumable using a consumption detecting
22 device, as recited in combination with the other features and limitations of claim 1.
23 Furthermore, Schulze fails to provide for rewarding a user of an imaging device
24 [when] the consumption of a predefined quantity of a consumable has been
25 detected, as recited in combination with the other features and limitations of claim 1.

Rather, Schulze is directed to a system (20) by which consumers (i.e.,
shoppers) voluntarily exchange conventional coupons (36) for exchange coupons

1 (40) on a one-to-one basis (Abstract; Col. 3, lines 60-67; Figs. 1A-1B of Schulze).
2 Upon checkout, the shopper (i.e., user) is provided with a check (48) in accordance
3 with the terms of any exchange coupon(s) (40) corresponding to the purchased item
4 or items (Col. 4, lines 1-5 of Schulze). However, Schulze is completely lacking any
5 mention or teachings related to the consumption of anything, as that term is used in
6 pending claim 1 and as supported by the specification.

7 The Examiner has alleged that the coupon sensor (132a) of Schulze is a
8 "consumption detecting device". Respectfully, the Examiner is mistaken. The
9 function of the sensor (132a) of Schulze is to detect the presence of a conventional
10 coupon (36) that has been inserted into coupon input unit (76a) by a user – this is
11 not the same as detecting the consumption of anything (Col. 7, lines 30-45 of
12 Schulze). In the context of pending claim 1, and as argued above in the Preliminary
13 Remarks, the term "consumption" in claim 1 refers to the use of a raw material
14 essential to the production of another entity. Under Schulze, a conventional coupon
15 (36) is not utilized as an essential material (i.e., ingredient) for the production of
16 anything else – quite the opposite is true, as an inserted coupon (36) is destined to
17 be destroyed (Col. 2, lines 45-50 of Schulze). In fact, the reference to Schulze is
18 completely devoid of the term "consumption", or any equivalent terminology, that is
19 consistent with the context of the pending Application.

20 In any case, Schulze is totally lacking any provision or suggestion of a
21 consumption detecting device, as recited in claim 1. In turn, Schulze is lacking any
22 provision of detecting consumption of a consumable using a consumption detecting
23 device, as recited by pending claim 1. Furthermore, Schulze does not provide for,
24 when the consumption of a predefined quantity of a consumable has been detected,
25 rewarding a user of an imaging device, as recited by claim 1. As a result, Schulze is
completely devoid of at least the foregoing elements and limitations as recited by

1 pending claim 1. For at least these reasons, the Applicants assert that the § 102
2 rejection of claim 1 is unsupportable and must be withdrawn.

3 In view of the foregoing, the Applicants further assert that claim 1 is allowable.
4 It is axiomatic that rejected claims 2-8 are also allowable at least by virtue of their
5 dependence from allowable claim 1, as well as for their own respectively patentable
6 features and limitations.

7
8 Claim 10

9 The Applicants contend that claim 10 (and rejected claim 11, which depends
10 therefrom), are not anticipated by Schulze. With respect to claim 10, that claim
11 includes the following recitations:

12
13 A method to promote the use of a plurality of consumables in an
14 imaging device including one or more consumption detecting devices,
15 comprising:

16 detecting consumption by the imaging device of individual
17 quantities of the plurality of consumables using at least one of the one
18 or more consumption detecting devices;

19 when a predefined collective quantity of the individual quantities
20 of consumables has been detected, rewarding a user of the imaging
21 device with a reward defined by a value; and

22 basing the value of the reward on the individual quantities of
23 each consumable that has been detected as being consumed by the
24 imaging device.

25 (Emphasis added.)

1 Schulze fails to provide an imaging device including one or more consumption
2 detecting devices, as recited in combination with the other features and limitations of
3 claim 10. Schulze also fails to provide detecting consumption by an imaging device
4 of individual quantities of a plurality of consumables using at least one of one or
5 more consumption detecting devices, as recited in combination with the other
6 features and limitations of claim 10. Also, Schulze fails to provide for when a
7 predefined collective quantity of individual quantities of consumables has been
8 detected, rewarding a user of an imaging device with a reward defined by a value,
9 as recited in combination with the other features and limitations of claim 10.
10 Furthermore, Schulze fails to provide basing the value of a reward on the individual
11 quantities of each consumable that has been detected as being consumed by an
12 imaging device, as recited in combination with the other features and limitations of
13 claim 10.

14 As a fundamental point, Schulze fails to provide for detecting consumption in
15 any way or for any purpose, and definitely not in the manner or context as recited by
16 pending claim 10. Accordingly, Schulze does not provide, teach or suggest
17 rewarding a user of an imaging device, basing that reward on individual quantities of
18 consumed consumables, or any other action responsive to consumption or detecting
19 consumption. Schulze is directed to solving a different problem (i.e., encouraging
20 store loyalty vs. rewarding a user for actual consumption within an imaging device)
21 in a different way (i.e., issuing checks in accordance with user purchases vs. issuing
22 a reward in accordance with detected consumption), than that of the subject matter
23 of pending claim 10. The Applicants assert that Schulze fails to provide at least the
24 limitations of claim 10 as described above, and the § 102 rejection of claim 10 is
25 unsupportable in view of the deficiencies of Schulze.

For at least foregoing reasons, the Applicants contend that claim 10 is allowable. It is axiomatic that claim 11 is also allowable at least by virtue of its

1 dependence from allowable claim 10, as well as for its own respectively patentable
2 features and limitations.

3
4 Claim 12

5 The Applicants contend that claim 12 (and rejected claims 13-16 that depend
6 therefrom), are not anticipated by Schulze. With respect to claim 12, that claim
7 includes the following recitations:

8
9 A method to promote the use of a consumable in a plurality of
10 imaging devices, each of the plurality of imaging devices including a
11 consumption detecting device, the method comprising:

12 detecting consumption of individual quantities of the
13 consumable by each of the imaging devices using the consumption
14 detecting device of each imaging device; and

15 when a predefined collective quantity of the individual quantities
16 of consumable has been detected, generating a reward.

17 (Emphasis added.)
18

19 Schulze fails to provide a plurality of imaging devices, each of the plurality of
20 imaging devices including a **consumption detecting device**, as recited as recited in
21 combination with the other features and limitations of instant claim 12. Also, Schulze
22 fails to provide **detecting consumption** of individual quantities of a consumable by
23 imaging devices using a **consumption detecting device of each imaging device**,
24 as recited in combination with the other features and limitations of instant claim 12.
25 Furthermore, Schulze fails to provide when a predefined collective quantity of
individual quantities of a **consumable** has been detected, generating a reward, as
recited as recited in combination with the other features and limitations of instant

1 claim 12. Schulze is therefore lacking at least the foregoing features and limitations
2 as positively recited by pending claim 12.

3 For at least these reasons, and for reasons analogous to those provided
4 above in regard to instant claims 1 and 10, the Applicant assert that the § 102
5 rejection of instant claim 12 is lacking support and must be withdrawn.

6 Therefore, the Applicants assert that claim 12 is allowable. It is axiomatic that
7 claims 13-16 are also allowable at least by virtue of their respective dependence (be
8 it direct or indirect) from allowable claim 12.

9
10 Claim 17

11 The Applicants contend that claim 17 (and rejected claims 18-19, 21 and 23-
12 24 which depend therefrom), are not anticipated by Schulze. With respect to claim
13 17, that claim includes the following recitations:

14
15 Apparatus for providing the user of an imaging device, which is
16 configured to consume a consumable, with a reward based on a
17 consumption of the consumable by the imaging device, comprising:

18 a consumable consumption detection device configured to
19 detect quantities of the consumable that are consumed by the imaging
20 device and to generate consumption signals in response thereto;

21 an electronic writeable memory device;

22 an electronic readable memory device configured to contain a
23 user reward message; and

24 a processor configured to receive the consumption signals and
25 to store a consumption value in the electronic writeable memory
device, the consumption value being a function of the received
consumption signals, the processor further configured to read from the

1 readable memory device the user reward message when the
2 consumption value is at least equal to a predetermined reward value,
3 and to visually display the reward message to the user.

4 (Emphasis added.)

5
6 Schulze fails to provide apparatus for providing the user of an imaging device,
7 which is configured to consume a consumable, with a reward based on a
8 consumption of the consumable by the imaging device, as recited in combination
9 with the other features and limitations of instant claim 17. Schulze fails to provide a
10 consumable consumption detection device configured to detect quantities of a
11 consumable that are consumed by an imaging device and generating consumption
12 signals in response thereto, as recited in combination with the other features and
13 limitations of instant claim 17. Also, Schulze fails to provide a processor further
14 configured to read from a readable memory device a user reward message when a
15 consumption value is at least equal to a predetermined reward value, and visually
16 displaying the reward message to a user, as recited in combination with the other
17 features and limitations of instant claim 17. The deficiencies of Schulze in regard to
18 pending claim 17 are analogous to those argued above in regard to pending claims
19 1, 10 and 12. In any case, Schulze fails to provide at least the foregoing particular
20 elements and limitations as recited by pending claim 17, and the § 102 rejection
21 thereof is unsupportable and must be withdrawn.

22 For at least the foregoing reasons, the Applicants assert that claim 17 is
23 allowable. As rejected claims 18-19, 21 and 23-24 depend (directly or indirectly)
24 from allowable claim 17, it is axiomatic that they too are also allowable at least by
25 virtue of their respective dependencies.

(Continued on next page.)

1 Claim 25

2 The Applicants contend that claim 25 (and rejected claims 26-31 that depend
3 therefrom), are not anticipated by Schulze. With respect to claim 25, that claim
4 includes the following recitations:

5
6 A computer-readable storage medium for use by a processor
7 configured to execute computer executable instructions to generate a
8 reward message in response to the consumption of a consumable by
9 an imaging device, the medium holding computer executable
10 instructions to:

11 detect consumption of the consumable; and
12 when the consumption of a predefined quantity of the
13 consumable has been detected, generate a reward message.

14 (Emphases added.)

15
16 Schulze fails to provide generating a reward message in response to the
17 consumption of a consumable by an imaging device, as recited in combination with
18 the other features and limitations of instant claim 25. Schulze also fails to provide
19 computer executable instructions to detect consumption of the consumable, as
20 recited in combination with the other features and limitations of instant claim 25.
21 Furthermore, Schulze fails to provide when the consumption of a predefined quantity
22 of a consumable has been detected, generating a reward message, as recited in
23 combination with the other features and limitations of instant claim 25.

24 Since Schulze fails to provide at least the foregoing limitations as positively
25 recited by claim 25, the § 102 rejection of claim 25 is unsupportable in view of the
deficiencies of Schulze, and the rejection should be withdrawn.

For at least these reasons, the Applicants assert that claim 25 is allowable.

1 The Applicants further assert that rejected claims 26-31 are also allowable at least
2 by virtue of their respective dependencies (direct or indirect) from allowable
3 claim 25.

4
5 Claim 33

6 The Applicants contend that claim 33 (and rejected claims 34-36 that depend
7 therefrom), are not anticipated by Schulze. With respect to claim 33, that claim
8 includes the following recitations:

9
10 A computer-readable storage medium for use by a processor
11 configured to execute computer executable instructions to generate a
12 reward message in response to the consumption of at least one
13 consumable by an imaging device, the medium holding computer
14 executable instructions to:

15 receive consumption signals from a consumption detection
16 device configured to detect quantities of at least one of the
17 consumables which are consumed by the imaging device;

18 [...];

19 generate the reward message when the consumption value is at
20 least the predetermined reward value and;

21 visually display the reward message.

22 (Emphasis added.)

23
24 Schulze fails to provide generating a reward message in response to the
25 consumption of at least one consumable by an imaging device, as recited in
combination with the other features and limitations of instant claim 33. Schulze also
fails to provide receiving consumption signals from a consumption detection device

1 configured to detect quantities of at least one consumable which is consumed by an
2 imaging device, as recited in combination with the other features and limitations of
3 instant claim 33. Schulze further fails to provide generating a reward message when
4 a consumption value is at least a predetermined reward value, as recited in
5 combination with the other features and limitations of instant claim 33. In view of the
6 forgoing deficiencies on the part of Schulze, the § 102 rejection of claim 33 is
7 unsupportable and must be withdrawn.

8 For at least these reasons, the Applicants assert that Schulze fails to provide
9 a plurality of limitations as positively recited by claim 33. Thus, the Applicants
10 contend that claim 33 is allowable. As claims 34-36 depend from claim 33, it is
11 axiomatic that they too are allowable at least by virtue of their dependence from an
12 allowable base claim, as well as for its own respectively patentable features and
13 limitations.

14
15 Rejection of Claims under 35 U.S.C. § 103

16 Claim 20 has been rejected under 35 U.S.C. § 103(a) as being obvious over
17 Schulze.

18 Rejected claim 20 depends (indirectly) from pending claim 17. As stated
19 above, the Applicants assert that independent claim 17 is allowable. Therefore, the
20 Applicants assert that claim 20, as respectively rejected under § 103, is also
21 allowable at least by virtue of its dependence from allowable independent claim 17.
22 As such, the Applicants do not believe it necessary to provide arguments in favor of
23 the rejected dependent claims.

24
25 (Continued on next page.)

1 Potentially Allowable Subject Matter

2 The Examiner has stated that claims 9, 22 and 32 are objected to as being
3 dependent upon a rejected base claim, but would be allowable over the prior art of
4 record if rewritten in independent form including all of the limitations of the
5 [respective] base claim and any intervening claims (page 5 of Office action). The
6 Applicants acknowledge and appreciate the Examiners indication of potentially
7 allowable subject matter. However, as argued above, the Applicants believe that
8 pending independent claims 1, 17 and 25 are allowable as-is. Therefore, the
9 Applicants assert that claims 9, 22 and 32 are also allowable at least by virtue of
10 their respective dependencies from an allowable base claim.

11
12 Summary

13 The Applicants believe that this response constitutes a full and complete
14 response to the Office Action. In view of the foregoing, the Applicants respectfully
15 request reconsideration on the merits of claims 1-36 in favor of timely allowance.

16 The Examiner is respectfully requested to contact the below-signed
17 representative if the Examiner believes this will facilitate prosecution toward
18 allowance of the claims.

19
20 Respectfully submitted,

21 Travis J. Parry and Robert Seek

22
23 Date: May 26, 2006

24 By



25 John S. Reid
Attorney and Agent for Applicants
Reg. No. 36,369
Phone: (509) 534-5789